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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,789	12/31/2003	William Roger Core	005781.00008	1014
28827	7590	03/24/2005	EXAMINER	
GABLE & GOTWALS 100 WEST FIFTH STREET, 10TH FLOOR TULSA, OK 74103			BOLES, DEREK	
			ART UNIT	PAPER NUMBER
			3749	
DATE MAILED: 03/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,789

Applicant(s)

CORE, WILLIAM ROGER

Examiner

Derek S. Boles

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, are drawn to an HVAC plenum, classified in class 454, subclass 255.
- II. Claims 4-9, are drawn to a diffuser, classified in class 454, subclass 292.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a diffuser. The subcombination has separate utility such as a diffuser for an air blower.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Paul Johnson on 3/17/05 a provisional election was made with traverse to prosecute the invention of II, claims 4-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-3 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Snyder (6,458,028).

See col. 2, lines 35-45.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Pellegrino (3,386,367). Snyder discloses all of the limitations of the claim(s) except for a smudge ring. Pellegrino discloses the presence of a smudge ring. See 20. Hence, one skilled in the art would find it obvious to modify the system of Snyder to include the smudge ring of Pellegrino for the purpose of dust prevention.

Claim(s) 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Cook (6,168,517). Snyder discloses all of the limitations of the claim(s) except for a circular cap that covers a central opening in the diffuser. Cook discloses the presence of a circular cap that covers a central opening in the diffuser. See col. 8, lines 19-27. Hence, one skilled in the art

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would find it obvious to modify the system of Snyder to include the circular cap that covers a central opening in the diffuser of Cook for the purpose of aesthetics.

Claim(s) 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Core (6,030,287). Snyder discloses all of the limitations of the claim(s) except for a planar damper configured to removably cover a preselected number of the radially extending air slot openings to providing means of selectably regulating the slot openings and bendable clips being fixed at one end to the circular structure. Core discloses the presence of a planar damper configured to removably cover a preselected number of the radially extending air slot openings to providing means of selectably regulating the slot openings and bendable clips being fixed at one end to the circular structure. See **150a**. Hence, one skilled in the art would find it obvious to modify the system of Snyder to include the planar damper configured to removably cover a preselected number of the radially extending air slot openings to providing means of selectably regulating the slot openings and bendable clips being fixed at one end to the circular structure of Core for the purpose of ease of removing.

Further, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Allowable Subject Matter


Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The provided references are representative of the state of the art that is applicable to the applicant's invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derek S. Boles at (571) 272-4872.

D.S.B.


DEREK S. BOLES
PRIMARY EXAMINER
GROUP 3700

3/21/05